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EXAMINER				
LONG, SCOTT				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/526,127

Applicant(s)

CAMPOCHIARO ET AL.

Examiner

SCOTT LONG

Art Unit

1633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 April 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3, 7, 8, 22, 27, 31, 36, 40 and 49.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/SCOTT LONG/
Examiner, Art Unit 1633

Continuation of 11, does NOT place the application in condition for allowance because:

The applicant has requested reconsideration of the pending rejections in view of the proposed claim amendments and arguments. The examiner has considered the applicant's arguments and claim amendments and found them insufficient to overcome the pending rejections.

The applicant has introduced the limitation, "replication-defective," into the instant claims. These claim amendments have been entered after final, because the art cited in the pending rejections teach this limitation and it is obvious to a skilled artisan to use replication defective viral vectors in gene therapy (see Poeschla, col.4, lines 63-64 and Rasmussen, page 1174, Conclusion).

Therefore, all the applicant's arguments directed to the absence of "replication defective" in the pending rejections is unpersuasive.

The applicant has made the following specific arguments:

III. Regarding the ODP rejection over application 10/080,797, the applicant states that he "will consider filing a Terminal Disclaimer on indication of otherwise allowable subject matter." As the applicant has not filed a terminal disclaimer, the provisional ODP is maintained

IV. The applicant has requested withdrawal of the provisional ODP rejection over copending Application No. 10/910293. The applicant has not provided sufficient rationale or claim amendments to sufficiently distinguish the invention of the instant claims from that of the copending application. As indicated in previous Actions, the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The instant application is directed to treating retinal edema, while the copending application, 10/910293, is directed to treating the retina of a subject in need of such delivery encompassing a large genus of diseases for which retinal edema is a symptom. Both applications use gene therapy methods to deliver nucleic acids encoding human endostatin. The claims of Application 10/910293 are more generic than those of the instant application, however, the claims of 10/910293 recite Markush groups which encompass the specific embodiment of the instant claims directed to methods of treating retinal edema with a lentivirus encoding endostatin. As the specification of 10/910293 teaches that subretinal injection is a species of their delivery methods, the claims of 10/910293 are obvious over the instant claims. This is a provisional double patenting rejection since the conflicting claims have not yet been patented. As the applicant has not filed a terminal disclaimer, the provisional ODP is maintained

V. The applicant has argued that the rejection of claims 1, 31, 36, and 40 under 35 U.S.C. 103(a) as being obvious over Leboulch et al (WO99/26480) in view of Poeschla et al. (US-6,555,107) and further in view of Brandt et al. (US-6106826) teaches away from the claimed invention (Remarks, pages 6-10). The applicant further argues that that the pending rejection does not provide a reasonable expectation of success (Remarks, page 10-13). The examiner has previously addressed these arguments and refers the applicant to the Action, filed 12/14/2009, pages 11-13. Therefore, the examiner finds the applicant's arguments unpersuasive and claims 1, 31, 36 and 40 remain rejected under 35 U.S.C. 103(a) as being obvious over Leboulch et al (WO99/26480) in view of Poeschla et al. (US-6,555,107) and further in view of Brandt et al. (US-6106826) for the reasons of record.

VI. The applicant has argued that the rejection of claims 1-3, 27, 31 and 49 under 35 U.S.C. 103(a) as being obvious over Rasmussen et al. (Drug Discovery Today, 22 November 2001; 6(20): 1171-1175) do not teach treating "retinal edema" (Remarks, page 12-13). Rasmussen is a review article that teaches a variety of anti-angiogenic gene therapy techniques for treating disorders of the eye, including treating proliferative diabetic retinopathy. Rasmussen particularly notes that proliferative diabetic retinopathy results in macular edema. Therefore, treating proliferative diabetic retinopathy by anti-angiogenic gene therapy treats its symptom, macular edema. The examiner also refers the applicant to the Action, filed 12/14/2009, pages 20-22. Therefore, the examiner finds the applicant's arguments unpersuasive.

VII. The applicant argues that in the rejection of claim 36 under 35 U.S.C. 103(a) as being obvious over Rasmussen et al. in view of Poeschla et al., Poeschla does not remedy the deficiency of Rasmussen discussed in section VI above. As the examiner has addressed Rasmussen's suggestion to treat macular edema found in diabetic retinopathy, the examiner finds this argument unpersuasive.

VIII. The applicant argues that in the rejection of claims 1-3, 27, 31, 40 and 49 under 35 U.S.C. 103(a) as being obvious over Rasmussen et al. in view of Nemerow et al., Nemerow does not remedy the deficiency of Rasmussen discussed in section VI above. As the examiner has addressed Rasmussen's suggestion to treat macular edema found in diabetic retinopathy, the examiner finds this argument unpersuasive.

Accordingly, as the applicant's claim amendments and arguments are found unpersuasive, the instant claims remain rejected for the reasons of record and the comments above.